

REMARKS

Claims 1-15 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 1, 2, 7, and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wooters in view of Bruhn, Jr. This rejection is respectfully traversed.

In the most recent Office Action the Examiner acknowledged that Wooters fails to teach or suggest a bracket member fixedly coupled to the frame, a pedal member having an arm portion and a pedal portion, the pedal portion being disposed on a first end of the arm portion, the pedal member being pivotally coupled to the bracket member at a second end of the arm portion such that the second end of the arm portion is elevated relative to the pedal portion. The Examiner asserts that Bruhn, Jr. cures these deficiencies simply through its combination with Wooters.

A. Improper Combination of References

Additionally, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness as required by *Graham v. John Deere Co.*, 148 USPQ 459 (1966) and MPEP § 2141. Specifically, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;

- (B) *The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;*
- (C) *The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and*
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

MPEP § 2141.01

A. THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION; HOWEVER, NEITHER WOOTERS NOR BRUHN INCLUDES SUCH SUGGESTION OF DESIRABILITY OF THE CLAIMED INVENTION.

Applicants respectfully submit that there is no teaching, suggestion, or motivation set forth in Wooters or Bruhn to combine these references to produce the claimed invention. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP § 2143.01 (emphasis added); *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Examiner is attempting to combine the teachings of the cited references to invent the present invention without any explicit motivation to combine such teachings. The most recent Office Action is completely silent of any recitation that would direct the Applicants to where such motivation can be explicitly found. The Examiner identifies portions of these patents that he relies upon, but fails to provide citations as to where he finds motivation to combine these references. More importantly, Applicants are being denied the opportunity to refute such motivation, since none is identified by the Examiner.

It is readily apparent that neither Wooters nor Bruhn provides any teaching, suggestion, or motivation to combine their teachings. Thus, without a teaching, suggestion, or motivation clearly found in within the text of these references, it is improper to combine these references to establish a rejection of obviousness, unless the Examiner can show that such teaching, suggestion, or motivation is generally available in the knowledge of one skilled in the art.

In the absence of any objective evidence or any convincing line of reasoning to combine these references, Applicants respectfully submit that each of the references, either singly or in combination, fail to teach or suggest the claimed invention and, thus, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, Applicants respectfully request reconsideration and withdrawal of the present rejections.

I. A Statement That A Modification Is Well Within The Skill In The Art Is Not Sufficient By Itself To Establish *Prima Facie* Obviousness.

In the most recent Official Action, the Examiner stated that “[i]t would have been obvious to have used the pedal assembly of Bruhn, Jr. in the golf car of Wooters since pedal assemblies are well known in the art for stopping and moving vehicles.” The Examiner simply picks and chooses among the references elements that allegedly teach the claimed invention. However, the Examiner has failed to show any motivation within these references to make such a combination.

As appropriately stated in MPEP § 2143.01, “[a] statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art’ at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is

not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.” *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)(emphasis in original); MPEP § 2143.01. That is, it is the Examiner’s burden to identify some objective reason to combine the teachings of the references. However, as stated above, the Examiner merely indicated that such combinations were “obvious”. Therefore, Applicants herein respectfully requests the Examiner to identify some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teaching.

II. The Examiner Must Present A Convincing Line Of Reasoning As To Why The Artisan Would Have Found The Present Invention Obvious.

Since, at this time, the Examiner has failed to provide any objective evidence found in the references to support the combination of these references, the Examiner must present a convincing line of reasoning as to why one skilled in the art would have combined these references. According to MPEP § 2142, it is the Examiner’s initial burden to provide some suggestion of the desirability of doing what the inventor has done. Specifically, “[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In the absence of any objective evidence or any convincing line of reasoning to combine these references, Applicants respectfully submit that each of the references, either singly or in combination, fail to teach or suggest the claimed invention and, thus, the Examiner has failed to establish a *prima facie* case of obviousness. Reconsideration and withdrawal of the present rejections are respectfully requested.

Claims 3-5 and 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wooters in view of Bruhn, Jr and in further view of MacDuff. This rejection is respectfully traversed. At the outset, Applicants respectfully direct the Examiner's attention to the arguments set forth above with regard to Claims 1, 2, and 8 above, as the present claims depend therefrom. Additionally, Applicants respectfully submit that MacDuff fails to cure the deficiencies of the Wooters and Bruhn. Accordingly, reconsideration and withdrawal of the present rejection are respectfully requested.

Claims 6 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wooters in view of Bruhn, Jr and in further view of Taig. This rejection is respectfully traversed. At the outset, Applicants respectfully direct the Examiner's attention to the arguments set forth above with regard to Claims 3 and 9 above, as the present claims depend therefrom. Additionally, Applicants respectfully submit that Taig fails to cure the deficiencies of the Wooters and Bruhn. Still further, in light of the dependency of Claims 6 and 12 upon Claims 3 and 9, Applicants respectfully submit that the Examiner's present rejection of Claims 6 and 12 is inconsistent with the

rejection of Claims 3 and 9, because the present rejection fails to include the MacDuff reference used to reject Claims 3 and 9. Accordingly, reconsideration and withdrawal of the present rejection are respectfully requested.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: June 2, 2004

By: 

Joseph M. Lafata, Reg. No. 37,166
Jeffrey L. Snyder, Reg. No. 43,141

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600

JLS/smb